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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,689	05/26/2006	William Neill White	SWIN 3354	3794
7812 7590 08/20/2009 SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006				
EXAMINER				
NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,689

Applicant(s)

WHITE ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-16, 18-20 and 22-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-16, 18-20 and 22-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments and arguments in the response dated June 12, 2009.

Claim Objections

2. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of claim 18 has been added to independent claim 1 through amendments.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 6, 8 – 10, 13 – 16, 18, 19, 26, 30, 31, 34, 35 and 37 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmasi et al. (USPN 6,214,443) in view of Faykish et al. (USPN 5,683,774).

Palmasi et al. disclose a security label (Abstract, lines 1 - 2) comprising: a carrier film (Figure 1, #14); a first layer of a polymeric coating printed on the film (Figure 1, #12), the polymeric coating comprising a UV rotary letter press ink (Column 5, lines 15 - 20), and the first layer defining affixing regions providing a first pattern (Column 4, lines 1 - 9), said affixing regions being substantially devoid of the first layer of polymeric coating (Figure 1, #16); a second layer of an affixing material comprising a plurality of affixing pigmented polymeric coatings to provide a second pattern on the label (Figure 1, ##16; Column 5, lines 15 - 20); wherein regions of the second layer adhere to the carrier film via the affixing regions of the first layer (Figure 3, #16; Column 3, lines 51 - 67); and the security label further comprises an adhesive to adhere the label to a support (Figure 1, #20) as in claim 1. With regards to claim 3, when the substrate is removed from the carrier film, the affixing portion of the second layer remains adhered to the carrier film (Figure 3, #16). With regards to claims 6 and 8 - 10, the carrier film comprises a plastic material, any other suitable polymeric material or paper, a light transmitting material and is transparent or translucent (Column 5, lines 21 - 23). Regarding claims 13 - 16, the first layer is formed of a light transmissive material, is transparent or translucent, clear and comprises a polymeric material (Column 2, lines 58 - 60). In regards to claim 19, the different affixing regions of the first layer have the shape of different letters, whereby words can be formed from said letters (Column 4, lines 1 - 9). With regard to claim 26, a sealing layer is provided between the second layer and the adhesive to prevent movement of the adhesive into the second layer (Figure 1, #18). Regarding claims 30 and 31, a pattern layer is provided on the second layer and the adhesive material is provided on the pattern layer, wherein the pattern layer comprises a metallized material (Figure 1, #18). With regard to claim 34 and

35, the second layer comprises a confuse pattern region to render unreadable any matter printed on the substrate (Figure 3) and an identification layer is provided for identification purposes (Column 4, lines 1 – 9). However, Palmasi et al. fail to disclose the first layer polymeric coating containing non-affixing regions, the first layer is substantially inadherable to the carrier film, the first layer is less adherable to the carrier than the second layer, the UV rotary letter press ink of the first layer comprises a short chain polymeric substance having a three-dimensional lattice structure and the second material comprises a UV rotary letter press ink comprising a long chain polymeric substance, having a two-dimensional structure.

Faykish et al. teach a security laminate (Figures) having a first layer polymeric coating (Column 4, lines 40 – 47) containing non-affixing regions (Figure 1 and 2, #12), the first layer is substantially inadherable to the carrier film (Figure 2, #12) and the first layer is less adherable to the carrier than the second layer (Figure 2, #12) for the purpose of causing the damage to the laminate to be in a pattern when it is removed from a document (Column 3, lines 24 – 28).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the first layer polymeric coating containing non-affixing regions in Palmasi et al. in order to cause the damage to the laminate to be in a pattern when it is removed from a document as taught by Faykish et al.

With regard to the limitations of the UV rotary letter press ink of the first layer comprises a short chain polymeric substance having a three-dimensional lattice structure and the second material comprises a UV rotary letter press ink comprising a long chain polymeric substance having a two-dimensional structure, Palmasi et al. clearly states that the resins used in the

patterned and image layer are UV curable chemicals (Column 5, lines 35 – 38) and that the type of UV material is dictated by the substrate on which it is placed and the final properties (Column 5, lines 43 - 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a short chain polymeric substance having a three-dimensional lattice structure and a long chain polymeric substance having a two-dimensional structure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. MPEP 2144.07.

5. Claims 7, 20, 22 – 25, 27 – 29, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmasi et al. (USPN 6,214,443) in view of Faykish et al. (USPN 5,683,774) as applied to claims 1 – 3, 6, 8 – 10, 13 – 16, 18, 19, 26, 30, 31, 34, 35 and 37 – 39 above, and further in view of Banahan (USPN 6,659,507).

Palmasi et al., as modified with Faykish et al., disclose the claimed security label except for a plastics material comprising polyester, the second layer comprises a plurality of pigmented polymer coatings, to allow printed matter in a desired pattern to be applied to the first layer as the second layer, the second material comprises a pigmented polymeric coating with a long chain polymeric structure, a release layer is provided on the second layer, wherein the release layer comprises a liner, including an adhesive resistant material, wherein the release layer may be provided on the adhesive layer, an adhesive is provided on the release layer, the adhesive being

coated thereon and so that it can be transferred to the second layer, wherein the adhesive comprises a hot melt adhesive curable by light, the label further includes a removal layer to allow the carrier to be removed from the support, the removal layer being provided on a removal region of the second layer and the identification layer includes an activatable material which defines an identification pattern.

Banahan teaches a security label (Column 1, lines 11 – 12) having the carrier film comprises a plastic polyester material (Column 2, lines 64 – 67), a release layer is provided on the second layer (Figure 1, #17), the release layer comprises a liner, including an adhesive resistant material (Column 3, lines 57 – 63), the release layer may be provided on the adhesive layer (Figure 1, #16 and 17) and wherein an adhesive is provided on the release layer (Figure 1, #16), the adhesive being coated thereon and so that it can be transferred to the second layer (Figure 3, #16), wherein the adhesive comprises a hot melt adhesive curable by light (Column 3, lines 60 – 63); the label further includes a removal layer to allow the carrier to be removed from the support (Column 4, lines 10 – 21), the removal layer being provided on a removal region of the second layer (Column 4, lines 10 – 21) and includes an identification layer includes an activatable material which defines an identification pattern (Figures 4A and 4B, #12) for the purpose of making a tamper-apparent and authenticating label (Column 1, lines 11 – 12).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the desired materials and layers in the modified Palmasi et al. in order to make a tamper-apparent and authenticating label as taught by Banahan.

With regard to the limitations of the second layer comprises a plurality of pigmented polymer coatings, to allow printed matter in a desired pattern to be applied to the first layer as the second layer, it would have been an obvious matter of design choice to change the color of the second layer since a modification would have involved a mere change in the color of a layer. A change in size, color or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). One of ordinary skill in the art would have been motivated to change the color of the second layer in order to change the visual attractiveness of the label. It is desirable to change the visual attractiveness of the label in order to make overall appearance more appealing to the consumer.

6. Claims 11, 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmasi et al. (USPN 6,214,443) in view of Faykish et al. (USPN 5,683,774) and Banahan (USPN 6,659,507) as applied to the claims above, and further in view of Gosselin et al. (USPN 5,885,677).

Palmasi et al., as modified with Faykish et al. and Banahan, disclose the claimed security label except for the carrier film having a thickness of less than 0.2mm, preferably less than 100 microns, the thickness is in the range of substantially 25 microns to substantially 50 microns and the removal layer comprises a silica compound.

Gosselin et al. teach a security label having a carrier film made of polyester (Column 4, lines 30 – 32) having a thickness of 0.051 to 0.102 mm (Column 4, lines 39 – 40; equals substantially 50 microns) and a removal layer comprising a silica compound (Column 4, lines 43

- 49) for the purpose of forming a security label having an identifier pattern (Column 1, lines 48 - 50).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the carrier film having the desired thickness and a removal layer with a silica compound in the modified Palmasi et al. in order to form a security label having an identifier pattern as taught by Gosselin.

Response to Arguments

7. Applicant's arguments with respect to claims 1 – 3, 6 – 16, 18 – 20 and 22 – 39 have been considered but are moot in view of the new ground(s) of rejection. However, since some of the same prior art is being used in the above rejections, the arguments will be responded to below.

In response to Applicant's argument that Palmasi fails to disclose the first layer of a non-affixing polymeric coating, please see the rejection above in view of Faykish et al.

In response to Applicant's argument that Palmasi uses a gravure roller or a transfer roller to place the layer of ink on the surface, for purposes of examination, product-by-process limitations are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a substrate with a polymeric layer on specific sections of the substrate. The reference suggests such a product. See the figures of Palmasi.

In response to Applicant's argument that Palmasi fails to disclose the UV rotary letter press ink of the first layer comprises a short chain polymeric substance having a three-dimensional lattice structure and the second material comprises a UV rotary letter press ink comprising a long chain polymeric substance having a two-dimensional structure, Palmasi et al. clearly states that the resins used in the patterned and image layer are UV curable chemicals (Column 5, lines 35 – 38) and that the type of UV material is dictated by the substrate on which it is placed and the final properties (Column 5, lines 43 - 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a short chain polymeric substance having a three-dimensional lattice structure and a long chain polymeric substance having a two-dimensional structure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. MPEP 2144.07.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

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